

REMARKS

This is in response to the Office Action that was mailed on January 28, 2008. Claims 1-7, 9, 10, 14-16, 18 and 19 were pending in that action. All claims were rejected. With the present response, claims 1 and 9 are amended. Claim 5 is cancelled. New claim 21 is added. The remaining claims are unchanged.

In the latest Office Action, all pending claims were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent Publication No. 2002/0078069 (hereinafter referred to as “the Moore reference”) in view of U.S. Patent No. 5,995,921 (hereinafter referred to as “the Richards reference”) and further in view of U.S. Patent No. 7,243,092 (hereinafter referred to as “the Woehler reference”). For reasons that will be explained in detail below, it is respectfully submitted that the pending claims are in allowable form.

Despite recent changes in the law related to application of 35 U.S.C. §103(a), the examiner still bears the initial burden of factually supporting any *prima facie* conclusions of obviousness. See M.P.E.P. Section 2142. In order to establish a *prima facie* case of obviousness in instances where multiple references are cited in combination, the Examiner must show that a suggestion exists for combining the references and that the combined references teach or suggest all recited claim limitations. Id. For reasons that will be thoroughly discussed below, it is respectfully submitted that, in the present case, the Examiner has failed to support any *prima facie* conclusion of obviousness.

I. DEFICIENCIES ASSOCIATED WITH THE PROPOSED COMBINATION

A. No Motivation to Combine

Applicant respectfully points out that the fact that a claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. See M.P.E.P. at Section 2143.01. Even in instances where references relied upon in combination do teach all aspects of a claimed invention, that still is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. Ex. parte Levengood, 28 USPQ2d 1300 (Bd Pat. App. & Inter. 1993).

It is fundamental that rejections under §103 must be based on evidence comprehended by the language of that section. In re Grasselli, 713 F2d 731 739 218 USPQ 769, 775 (Fed. Cir. 1983). The factual inquiry whether to combine references must be thorough and searching. Id. It must be based on objective evidence of record. Particular findings must be made as to the reason a skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 217 F3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

In the latest Office Action, in order to reject Applicant's claims, the Examiner presents a combination of three references taken from the diverse areas of art. As an explanation of why the proposed combination would be obvious, the Examiner simply identifies a benefit associated with two of the three references. However, no indication is given as to why one skilled in the art would have been so motivated to combine the references in order to achieve the stated benefits. No specific citations are made to any of the three references that would show a teaching or suggestion for combining the references. No explanation is given as to what knowledge possessed or specific principle by a skilled artisan would lead to the combination. No recognition is given to applicable trends in the art. No explanation is provided as to how knowing the problem or recognizing a potential benefit would lead to the claimed invention.

For example, on page 3 of the Office Action, the Examiner states that it would have been obvious to combine the Richards and Moore references because doing so would "provide an improved help interface capable of receiving user-defined queries in a natural language and selecting the most appropriate answer from a plurality of potential answers through which user can interact with software." Notably, the stated motivation has very little or nothing to do with the objective of the rejected claim. Further, the stated motivation, which is essentially a brief explanation of the purpose of the Richards teachings, has little or nothing to do with the purposes of the teachings of the Moore reference. Simply put, the quoted objective of the Richards reference has nothing to do with the objective of the cited Moore reference and, perhaps more notably, has nothing to do with the objective of the rejected claim.

Similarly, on page 4 of the Office Action, the Examiner states that it would be obvious to combine the teachings of the Woehler reference with the teachings of the Moore and Richards references because it would enable “generation of a large number of meaningful terms from a document collection, creating a taxonomy from these terms, and filling the taxonomy with documents from the collection.” Again, the quoted function of the Woehler reference has little or nothing to do with the other two cited references. It is impossible to understand how this statement about the Woehler reference provides any reasonable explanation as to why it would be obvious to combine the reference with the Moore and Richards references.

It is also worth noting that it is not immediately apparent how one might go about combining the teachings of the Woehler, Richards and Moore references. The Moore reference pertains to an organized system for creating a file name. The Richards reference pertains to a system for a query and identifying base words to be utilized for comparison purposes against a collection of potential query answers. The cited Woehler reference pertains to a system for automatically creating a term taxonomy for a collection of documents and then filling the taxonomy with documents from the collection. Applicant questions how the file naming scheme of the cited Moore reference fits into the teachings of the Richards and Woehler references. It would seem that such a combination is in fact arbitrary and unmotivated.

When the prior art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleamed from the invention itself. Uniroyal Inc. v. Rudkin-Wiley Corp., 5 USPQ2d 1434 (Fed. Cir. 1988). In the present application, no such reason has been provided to explain the selection and combination of certain teachings from each applied reference. The only conclusion that can be reached from the alleged combinability of the references is the impermissible hindsight gleamed from the present invention. See, e.g., Ex parte Haymond, 41 USPQ2d 1217, 1220 (The Bd. Pat. App. & Int. 1996)(The examiner “may not, because he doubts that the invention is patentable resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis”).

Simply stated, the Office Action does not provide any objective evidence that shows a motivation to combine the references. Without such objective evidence, no *prima facie* case of obviousness has been made. Accordingly, the rejection of claims 1-7, 9, 10, 14-16, 18 and 19 is improper.

B. COMBINATION COMPLEXITY FURTHER WEAKENS CASE FOR §103 OBVIOUSNESS

In order to reject Applicant's claims, the Examiner has cited three references from dissimilar areas of technology. For example, one reference relates to an automated scheme for assigning a name to a file (Moore). Another references pertains to a system for parsing base words out of a query for subsequent utilization for comparison purposes against a collection of potential query responses (Richards). The third reference pertains to a method for automatically generating a term taxonomy for a collection of documents and filling the taxonomy with documents from the collection (Woehler).

Applicant recognizes that the Examiner has the right to combine any number of references in order to reject the claims, so long as the references in combination teach the recited elements and a suggestion exists for combining them. As was stated above, Applicant submits that the Examiner has provided no suggestion to combine the three references in any combination. In addition, Applicant respectfully submits that, because the Examiner is required to combine so many diverse references in order to even reject the claims, this in and of itself, argues that the claims are non-obvious because the combinations of references are non-obvious. At some point, it becomes clear that no one skilled in the art could ever even conceive such a complex and diverse combination, much less consider the combination obvious. Applicant respectfully submits that the cited rejections have moved beyond that point.

C. THE COMBINED REFERENCES FAIL TO TEACH OR SUGGEST ALL THE RECITED CLAIM LIMITATIONS

In the spirit of cooperation, Applicant has amended independent claim substantially with the present response. As amended, claim 1 now recites providing access to a collection of taxonomic organization data. As claimed, the taxonomic organization data relates

each word selection in the claimed limited set to a taxonomic category. Further, as claimed, the taxonomic category for each word selection is not apparent in the word selection itself.

It is respectfully pointed out that none of the cited references teach or suggest providing access to a collection of taxonomic organization data as claimed. The cited Woehler reference does teach an automatic generation of a term taxonomy based on a collection of documents. However, at no point in time is a taxonomic category ever assigned to a word selection provided to a user as claimed. The other cited references do not make up for this inability of the Woehler to teach or suggest these claim elements.

Further, as amended, claim 1 now recites automatically determining, based at least in part on a reference to the taxonomic organization data, a particular taxonomic category that corresponds to the particular word selection.

It is respectfully pointed out that none of the cited references teach or suggest assigning a taxonomic category based on a user-initiated selection from a limited set of word selections. The cited Woehler reference assigns taxonomic categories automatically. There is absolutely no teaching or suggestion in the Woehler reference of assigning taxonomic categories based on user selections. The other cited references do not make up for the inability for the Woehler reference to teach or suggest these claim elements.

Finally, as amended, claim 1 now recites enabling a user to sort a claimed file based on the user's word selection or the associated particular taxonomic category. Further, as claimed, the result of a sort based on the particular taxonomic category is not the same as the result of a sort based on the particular word selection.

There is absolutely no teaching or suggestion in the cited Woehler reference of an ability to sort based on a user-selected input. Certainly, there is no teaching or suggestion of an ability to sort based on a taxonomic category assigned to such an input. The other two cited references do not remedy the inability of the Woehler reference to teach or suggest these claim limitations.

For at least these reasons, it is respectfully submitted that independent claim 1 is in allowable form.

Dependent claims 2-4, 6 and 7 are dependent upon independent claim 1 and are believed to be in allowable form at least based on their reliance upon what is believed to be an allowable independent claim. This is not to say that some or all of these dependent claims do not themselves recite limitations that are independently patentable.

In the spirit of cooperation, independent claim 9 is also amended with the present response. As amended, the claim is similar to claim 1 in that a taxonomic category is automatically associated with a file based on a user-initiated selection of an element within a task identifier. In fact, claim 9 goes another step farther and recites an assignment of multiple taxonomic categories. Further, claim 9 is limited to assigning the multiple taxonomic categories to "an action element" portion of a claimed task identifier. Still further, independent claim 9 limits the claimed multiple taxonomic category to being "pre-signed to the action element."

It is respectfully pointed out that the cited Woehler reference does not teach or suggest the noted limitations of claim 9. The Woehler reference does not describe any assignment of a taxonomic category to a user-initiated input, let alone assignment of a taxonomic category to an action element selected by a user to be part of a task identifier as claimed. Further, the cited Woehler reference does not teach or suggest assigning multiple taxonomic categories to such an action element, let alone pre-assigning the categories. The other cited references do not remedy the inability of the Woehler to teach or suggest the noted claim limitations. For at least these reasons, it is respectfully submitted that independent claim 9 is in allowable form.

Dependent claims 10, 14 and 15 are dependent upon independent claim 9 and are believed to be in allowable form at least based on their reliance upon what is believed to be an independent allowable claim. This is not to say that these dependent claims do not themselves recite limitations that are believed to be independently allowable.

Independent claim 16 also recites assigning taxonomic categories to words that are made available to a user for selection to be made part of a task identifier. As has been noted, the cited references fail to teach or suggest any such configuration. Claim 18 is similarly distinguishable.

Independent claim 19 recites assigning a task identifier to a help file. As claimed, the task identifier includes an element selected from a limited category. Further, as claimed, the help file is sorted based at least in part on a taxonomic category assigned to the element selected from a limited vocabulary. The cited Woehler reference in no way teaches or suggests assigning a taxonomic category to an element selected from a limited vocabulary. The reference simply teaches creating a taxonomy based on information derived from a collection of documents. The terms included in the Woehler taxonomy are not selected from a limited vocabulary. Instead, they are selected by applying an algorithm to the content of a collection of documents. For at least this reason, it is respectfully submitted that the claims are patentably distinguishable from the cited Woehler reference. It is respectfully submitted that the other two cited references do not remedy the inability of the cited Woehler reference to teach or suggest the elements of claim 19. With the present response, new independent claim 21 has been added. This new claim is consistent with claim 8 as originally filed. This new claim is believed to be in allowable form at least for its dependence upon what is believed to be an allowable claim.

In summary, it is respectfully submitted that claims 1, 2-4, 6, 7, 9, 10, 14-16, 18, 19 and 21 are in allowable form. Consideration and allowance of all pending claims are respectfully solicited.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By: Christopher L. Holt

Christopher L. Holt, Reg. No. 45,844
900 Second Avenue South, Suite 1400
Minneapolis, Minnesota 55402-3319
Phone: (612) 334-3222 Fax: (612) 334-3312

CLH:rkp